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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,868	11/05/2001	Gerald William O'Grady	4148P030C	8298
7590	09/26/2005		EXAMINER	
Andre L. Marais BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1026			LEE, PING	
			ART UNIT	PAPER NUMBER
			2644	
DATE MAILED: 09/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/993,868	O'GRADY ET AL.
	Examiner	Art Unit
	Ping Lee	2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 July 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-72 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-72 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/5/01, 3/20/02</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I in the reply filed on 7/21/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Applicant elected Group I. However, the election requirement is based on two distinct species corresponding to Fig. 1 and 2 respectively. For examination purpose, all the claims that read on Fig. 1 will be examined. All other claims, including amended claims and/or additional claims after this office action, will be withdrawn from further consideration.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 18 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 18, the phrase "the parameter read commands" lack antecedent basis.

Regarding claim 53, the phrase "the control interface" lacks clear antecedent basis.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6, 8, 10-33, 35 and 72 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (US006526287B1).

Regarding claims 1-3 and 72, Lee discloses an integrated accessory (battery pack) for a host device (cellular phone), the accessory including: a media decoder (172) operationally to decode an encoded media file (from 16); a battery (11) coupled to the media decoder (172) operationally to provide power to the media decoder (172); and a connector (13) electrically and removably to couple the accessory to a host device (col. 2 lines 49-50), wherein the battery is coupled to the connector (13) to allow the battery operationally to provide power to the host device (col. 2, lines 46-48).

Regarding claim 4, Lee shows the housing (10) in Fig. 1.

Regarding claims 5 and 6, Lee shows a mobile telephone.

Regarding claim 8, Lee shows that the connector provides a control interface (171) whereby data communications are operationally facilitated between the media decoder and the host device.

Regarding claims 10-16, Lee shows that the data communications include

commands provided from the host device to the media decoder and wherein the commands include control commands to control operation of the media decoder (col. 3, lines 11-13).

Regarding claims 17-23, Lee shows that the commands include parameter read commands to read parameters of the media decoder (col. 3, line 57+).

Regarding claims 24 and 35, although not explicitly shown, an interface is inherently provided.

Regarding claim 25, although not explicitly shown the DAC is inherently included in the host device (122 in Fig. 4) in order to convert the digital signal (PCM data from MP3 player) to the analog signal for the speaker (132).

Regarding claims 26 and 27, Lee shows the DAC (col. 2, lines 63-64) and the output jack (14).

Regarding claims 28-30, 32 and 33, Lee shows the memory (16).

Regarding claim 31, although not explicitly shown, at least one decompression algorithm is inherently stored in the memory in order to allow the MP3 player to decode the compressed audio file.

Claims 39-43, 45-60, 62-64, 66-68 and 70 have limitations which read on the limitations in the apparatus claims as discussed in claims 1-6, 8, 10-33 and 35 above.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7, 44 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Chiang (US005864766A).

Regarding claims 7, 44 and 65, Lee fails to show the power converter. Lee teaches a general power supply to provide appropriate power for the memory, the codec, the controller, the CPU and the host device. Since all elements are not being powered by the same voltage, one skilled in the art would have expected that the battery in Lee inherently has a converter to provide different power levels for different elements mentioned above. Nevertheless, Chiang teaches an example of how to convert the power from the battery to the proper (Fig. 2) (col. 2, lines 38-40). Thus, it would have been obvious to one of ordinary skill in the art to modify Lee in view of Chiang by using a power converter in order to power the electrical elements with proper levels.

9. Claims 9, 36, 61 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee.

Regarding claims 9, 36 and 71, Lee fails to show I<sup>2</sup>C interface and USB interface. Lee teaches a general concept of incorporating MP3 player with a battery pack for a cellular phone. However, one skilled in the art would have expected that any specific interface, including I<sup>2</sup>C interface and USB interface, could be used for providing communication without generating any unexpected result. Thus, it would have been obvious to one of ordinary skill in the art to modify Lee by using I<sup>2</sup>C interface and USB

interface for providing communication between cellular phone and the MP3 player because it was considered as a matter of design choice.

Regarding claim 61, Lee fails to explicitly show the program code. Lee teaches a MP3 player which stores and plays audio files. The MP3 player could be used as a stand-alone unit without the cellular phone. One skilled in the art would have expected that the MP3 player has its own operating code to automatically perform the functions for the MP3 player when the MP3 player is switched on. Thus, it would have been obvious to one of ordinary skill in the art to incorporate operating code for the MP3 player.

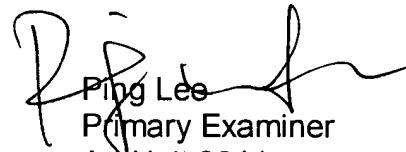
10. Claims 34 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Miyashita (US006244894B1).

Regarding claims 34 and 69, Lee fails to show a removable memory card. In the same field of endeavor, Miyashita teaches a battery pack with a slot allowing a removable memory card (30 or 40) to provide extra memory capacity or operational function. Thus, it would have been obvious to one of ordinary skill in the art to modify Lee by incorporating the capability of accepting a memory card as taught in Miyashita in order to further expand the stored audio files and operational functions.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ping Lee whose telephone number is 571-272-7522. The examiner can normally be reached on Monday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian C. Chin can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ping Lee  
Primary Examiner  
Art Unit 2644

pwl